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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/187,749	11/09/1998	KENICHI UTSUMI	1080.1067/JD	3456

7590

04/12/2002

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EXAMINER

IRSHADULLAH, M

ART UNIT

PAPER NUMBER

2163

DATE MAILED: 04/12/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

NM:



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EXAMINER

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NM

Office Action Summary

Application No.

09/187,749

Applicant(s)

UTSUMI ET AL.

Examiner

M. Irshadullah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 4 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. This communication is in response to the amendments filed October 30, 2001.

Summary Of Instant Office Action

2. Applicant's arguments, filed October 30, 2001, concerning claims 1-8 rejections, para 8, Paper No. 7, Office Action, mailed July 03, 2001 have been considered, deemed unpersuasive and the rejections are maintained.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8 are rejected under 35 U.S.C. 103(b) as being unpatentable over Ross et al (US Patent 5,553,139) in view of Hasebe et al (US Patent 5,392,351).

Ross et al disclose:

Claim 1. A license devolution apparatus [Title and col 1, lines 7-8] accessing a first storage medium storing contents encrypted with a predetermined key [Col 1, line 57, recited with lines 52-53, Fig. 6B described col 1, lines 46-51, Fig. 5 (Enabler Keys), Fig. 2 (210, 216,

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218) recited with col 6, lines 1-3, 8-13, 16 and 19-20. It needs be mentioned that the use of a predetermined (enabler) key or a key generated during encryption process are notoriously known in the art under discussion], a first media ID identifying the first storage medium [Please see discussion below], and a first encryption secure information generated by encrypting the key and a first use information, representing a right to use the contents, together with one another or individually, with the first media ID, and accessing a second storage medium, storing a second media ID identifying the second storage medium [Please see discussion below], wherein the right of using the contents stored in said first storage medium is devolved from said first storage medium to said second storage medium [Col 6, line 49, col 1, lines 51-54 read with lines 37-38 (application/content of first media/CD and by the same token another application program/content relating to second media/diskette), and col 6, lines 40-49 together with lines 52-54], yet

Ross et al do not show:

a first media ID, identifying the first storage medium,
(storing) a second media ID identifying the second storage media.

However, Hasebe et al teach the same [Fig. 2 (12) described col 2, lines 9-12, col 9, lines 1-9].

It would have been obvious to one of ordinary skill in the license/information protection/securing art at the time of applicant's invention to include media IDs in Ross et al's invention, because it would provide additional/enhanced protection to electronic data/information in addition to copyright protection.

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said license devolution apparatus comprising:

a) decoding means for decoding the first encryption secure information stored in said first storage medium using the first media ID to obtain the key and the first use information [Ross et al: Col 4, lines 22-24, col 6, lines 40-59 (specifically line 49, 52-56), col 7, lines 28-40, 47-55, Fig 4 described col 7, lines 56-65 continue col 8, lines 5-8, and Fig. 7 (C, D, E), and discussion about media ID above]; and

b) encryption means for encrypting with the second media ID, the key and a second use information, representing a second right to use the contents that is devolved from the first storage medium to the second storage medium together with one another or individually with the second media ID, to generate a second encryption secure information for storage in said second storage medium [Ross et al: Fig 2 (210, 218), Fig. 5 (A, B), col 3, lines 17-24, col 6, lines 40-49 and 51-52 recited with col 4, lines 8-15, col 3, lines 34-45 and col 7, lines 32-55, and discussion about media ID above].

Claim 2. A license devolution apparatus according to claim 1, wherein said encryption means encrypts with the first media ID a third use information, obtained through subtracting the second use information from a first use information, or encrypts with the first media ID both the key and the third right of using, to generate a third secure information and stores the third encryption secure information in the first storage medium [Ross et al: Fig. 2 (210, 218), Fig 5 (A, B), Fig. 5 (any of 2-4 would be considered as third user of the third right

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of using and obtained by eliminating/subtracting the second right of using from the first right of using) and col 3, lines 40-45, and discussion about media ID above].

Claim 3. A license devolution apparatus according to claim 1, wherein if the entire rights of using the contents, to which the first storage medium is entitled, are devolved to the second storage medium [Claim 1, lines 37-41, col 4, lines 8-15 and col 6-col 7(up to line 20)], the first encryption secure information stored in the first storage medium is destroyed [Ross et al: Fig. 1 (102), col 4, lines 16-18. Applicant will appreciate that reference's disabling function/process would be used to disable/erase/delete/destroy the secure information stored in the first storage medium after transferring the information to another/second etc. media].

Claim 4. A license devolution apparatus according to claim 1, wherein before devolution of the right to use the contents, the first storage medium stores contents whose right to use is intended to be devolved as encrypted contents [Figs. 6A and 6B described col 1, lines 31-61], and

wherein said license devolution apparatus further comprises contents transfer means for reading the encrypted contents from the first storage medium, and storing in the second storage medium the read encrypted contents [Claim 1, lines 37-41. Reading devices, like diskette or CD drives are inherently implied].

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Claim 5. A license devolution apparatus according to claim 2, wherein the first use information and the second use information represent the presence of the right to use, and the third use information represents the absence of the right to use [Fig. 5, any of 2-4 would be a first (user) of first use information, a second (user) of second use of information and when two are using the use information, third one (say, installer) would be unable/absent to have the right of using the use information unless the use information is transferred/distributed/devolved simultaneously to all].

Claim 6. A license devolution apparatus according to claim 2, wherein the first use information represents of a first available number of times or available time, the second use information is represents a second available number of times or available time which is less than the first available number of times or available time, and the third use information represents a third available number of times or available time which is obtained through subtracting the second available number of times or available time from the first available number of times or available time [Inherently implied, since the user under the agreement would be obliged to use the product (document, picture or program) for certain number of time(s) and when one user would transfer/devolve the right of use, he could only do so for the remainder of one's available number of times].

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Claim 7. A license devolution apparatus according to claim 1, further comprising a first drive and a second drive driving the first storage medium and the second storage medium, respectively, said first drive and said second drive having a first firmware and a second firmware accessing the first storage medium and the second storage medium, respectively [Inherently implied; the diskette or CD or other media drives have their respective drivers or softwares/firmwares for running the same],

wherein said decoding means and said encryption means are arranged in a firmware consisting of said first firmware and said second firmware in form of a composite unit; and wherein only said first firmware has authority to access the first storage medium driven by said first drive, and only said second firmware has authority to access the second storage medium driven by said second drive [Inherently implied; each driver (software/firmware) would be able (have authority) to run its respective media having an ID and access the information on it].

In the following claim Ross et al show: “ a predetermined key [Fig. 5 (Enabler Key)]”, and do not explicitly show “ storing in storage media ”.

Claim 8. A license devolution method, comprising:

However, Hasebe et al teach the following except above mentioned “ predetermined key ”:

a) storing in a first storage medium contents encrypted with a predetermined key, a first media ID identifying the first storage medium, and encryption secure information generated by encrypting with the first media ID, the key and a first use information, which represents a right to

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use the contents [Fig. 4 (s3, s6, s7) described col 6, lines 3-43, Fig. 2 (12, 13, 14), col 4, lines 10-15. Col 5, lines 3-7].

“Storing” in computer art is notoriously known. It would have been obvious to one of ordinary skill in the art at time of instant invention to use the available technique/procedure.

Following steps are method steps of apparatus claim above, same rationale applies as to elements claim 1(a) and 1 (b) above.

b) decoding the first encryption secure information using the first media ID to obtain the key and first use information;

c) generating a second encryption secure information by encrypting with a second media ID, which identifies a second storage medium, the key and second use information, which represents a second right to use the contents that is devolved from the first storage medium to the second storage medium; and

storing the second encryption secure information in said second storage medium, wherein the right to use the contents stored in the first storage medium is devolved from the first storage medium to the second storage medium [Hasebe et al: Fig. 4 (s3, s6, s7), col 6, lines 3-43 read with col 4, lines 62-64, col 9, lines 6-9].

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Response to Arguments

5. Applicant's arguments filed October 30, 2001 have been fully considered, and the references are deemed to meet the invention as claimed by applicant's claims 1-8.

However, in response to applicant's argument that the references of Ross et al (US Patent 5,553,139) and Hasebe et al (US Patent 5,392,351) fail to show/teach features of applicant's invention (applicant's Remarks, pages 2-6), it is noted that the features upon which applicant relies; i.e., devolving, the permission information from one recording medium to another recording medium or revising the permission information on a recording medium responsive to use (consumption) of content/information being protected by the permission information, are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after


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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Irshadullah whose telephone number is (703) 308-6683. The examiner can normally be reached on M-F from 11:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax numbers for the organization are (703)746-7239, and for after Final, (703)746-7238.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-3900.


M. Irshadullah

February 07, 2002

*SAN ROMAN
PRIMAR EXAMINER
AU 2166*